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09/579,938	05/26/2000	Timothy J Williams	TJW-00100	8295

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HAVERSTOCK & OWENS LLP  
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SUNNYVALE, CA 94086

EXAMINER
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SORKIN, DAVID L

ART UNIT	PAPER NUMBER
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1797

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12/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/579,938	Applicant(s) WILLIAMS, TIMOTHY J	
	Examiner David L. Sorkin	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on N/A.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-11 and 13-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 27 is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-11, 13-19, 21-26 and 28-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Prosecution is reopened, in view of the BPAI decision, to address means plus function recitations in further detail.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 4 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by DeVito (US 5,842,606). In claim 1 "means for dispensing..." is recited. As stated on page 2, line 21 of the instant specification "the means for dispensing paint includes a spigot assembly". As stated on page 10, lines 6-9 of the instant specification, "any other known appropriate spigot or dispensing assembly 100 may be used to dispense paint from the paint storage container 48, including a lever type spigot assembly with a similar threaded receiving end designed to couple with the elongated portion of the top screw device 110". DeVito ('606) discloses a container comprising a plurality of compartments (a plurality of 34) having a front, a back, a first side, a second side and a base; a frame (a plurality of 12 joined together as disclosed) holding the compartments; and means (52, which is a lever type threaded spigot assembly and therefore a

'corresponding structure') for dispensing removably coupled to the base of the compartments, wherein the means for dispensing is capable of dispensing without lifting the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also *In re Schreiber*, 44 USPQ2d 1429, 1931 (Fed. Cir. 1997), where a claimed popcorn dispensing spout was held anticipated by a spout for dispensing oil from an oil can. The container of DeVito ('606) is intended to hold liquids (see col. 1, lines 6-8) and clearly would be capable of holding and dispensing paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 5). Regarding claim 4, the frame includes mounting slots (38). Regarding claim 29, a structure which dispenses beverages would be capable of dispensing paint, because the term "paint" includes liquids of similar consistency to common beverages. Applicant argues that a dispensing mechanism which allows paint to flow is necessarily bigger than the size of a beverage dispensing mechanism. Contrary to applicant's arguments, paint may be in the same viscosity range as beverages. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24), while Cole-Palmer's Food

TechSource discloses that milk, cream and tomato juice have viscosities of 3.2, 16.5, and 176 centipoise respectively.

4. Claims 1, 3, 4 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Briggs (US 6,109,482). In claim 1 "means for dispensing..." is recited. As stated on page 2, line 21 of the instant specification "the means for dispensing paint includes a spigot assembly". As stated on page 10, lines 6-9 of the instant specification, "any other known appropriate spigot or dispensing assembly 100 may be used to dispense paint from the paint storage container 48, including a lever type spigot assembly with a similar threaded receiving end designed to couple with the elongated portion of the top screw device 110". Briggs ('482) discloses an container comprising a plurality of compartments (see Fig. 5) having a front, back, first and second side and base; a frame (a plurality of 12 joined together as shown in Fig. 2) holding the compartments; and means (22 or 39 which is a spigot assembly and therefore a corresponding structure) for dispensing removably coupled to the base of the compartments for dispensing from the compartments, wherein the means for dispensing is capable of dispensing without lifting the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. See also *In re Schreiber*, supra., where a claimed popcorn dispensing spout was held anticipated by a spout for dispensing oil from an oil can. The container of Briggs ('482)

is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding and dispensing paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 3). Regarding claim 4, the frame includes mounting slots (42). Regarding claim 29, a structure which dispenses beverages would be capable of dispensing paint, because the term "paint" includes liquids of similar consistency to common beverages. Applicant argues that a dispensing mechanism which allows paint to flow is necessarily bigger than the size of a beverage dispensing mechanism. Contrary to applicant's arguments, paint may be in the same viscosity range as beverages. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24), while Cole-Palmer's Food TechSource discloses that milk, cream and tomato juice have viscosities of 3.2, 16.5, and 176 centipoise respectively. Note also the dispensing mechanism of Briggs ('482) is so big that it fits around the neck of a 2-liter soda bottle (see col. 4 lines 14-18).

5. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Corbin et al. (US 2,848,019) discloses a paint storage container comprising one or more colors of paint (see col. 9, lines 66-73); a plurality of paint storage compartments (24) each for storing a color paint, each paint storage compartment having a front, a back, a first side, a second side and a base (see Figs. 1, 4 and 15); a frame (20,22) holding the paint storage compartments; and a dispensing mechanism (43,33) coupled to the base of the paint storage compartments for dispensing paint from the paint storage compartments,

wherein the dispensing mechanism is capable of dispensing paint without lifting the paint compartments (see col. 3 line 21 to col. 4 line 2).

6. Claims 1, 3-7, 9-11, 13-19, 22-26 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017). In claim 1 "means for dispensing..." is recited. As stated on page 2, line 21 of the instant specification "the means for dispensing paint includes a spigot assembly". As stated on page 10, lines 6-9 of the instant specification, "any other known appropriate spigot or dispensing assembly 100 may be used to dispense paint from the paint storage container 48, including a lever type spigot assembly with a similar threaded receiving end designed to couple with the elongated portion of the top screw device 110". Reed ('017) discloses a container comprising a plurality of compartments (24,27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; and means (15,16, which is a spigot assembly and therefore a corresponding structure) for dispensing coupled to the base. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the dispensing means is

removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 3, the dispensing means is a spigot assembly (see col. 5, lines 11-37). Regarding claim 4, the frame includes slots (101'). Regarding claim 5, one or more removable lids (25, 26 and/or 3) selectively cover the paint compartments, and means for stirring (111, 112, 113, 114) are removably coupled to the lids. The instant specification states at page 2 line 26 to page 3 line 5, "The means for stirring further includes a circular base having a central axis, wherein the circular base is configured for rotating about the central axis, a rod coupled to the circular base at the central axis such that the rod spins when the circular base is rotated about the central axis and a stirring fan apparatus removeably coupled to the rod and having a plurality of fins which extend outwardly from the stirring fan apparatus and rotate about the central axis when the circular base is rotated", which is precisely what Reed ('017) discloses as seen in Fig. 5. Regarding claim 6, the stirring means further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 7, Reed ('017) discloses a container comprising a plurality of compartments (24, 27), each having a front, a back, a planar first side and a planar second side and a base (see Fig. 2, 3 and 5; col. 3, lines



15 and 16); a frame (2) holding the compartments; lids (25,26 and/or 3); a stirring assembly (111,112,113,114) removably coupled to the lid(s); and a dispensing mechanism (15,16) coupled to the base. The dispensing mechanism is capable of dispensing without lifting the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 9, the frame includes slots (101'). Regarding claim 10, the stirring means further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 11, Reed ('017) discloses a container comprising a plurality of compartments (24,27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; a dispensing mechanism (15,16), one or more removable lids (25, 26 and/or 3) covering the compartments; and a stirring assembly (111,112,113,114) removably coupled to the

lids. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra.

Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the dispensing means is removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 13, the dispensing mechanism includes a spigot assembly (see col. 5, lines 11-37). Regarding claim 14, the frame includes slots (101'). Regarding claim 15, the stirring assembly further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 16, Reed ('017) discloses a reusable container comprising a plurality of compartments (24,27) each having a first front, a first back, a first side, a second side and a base; body (2) holding the paint compartments having a second front, a second back, a planar third side and a planar

fourth side (see Fig. 1); one or more removable lids (25, 26 and/or 3) coupled to the paint compartments having an outer side, an inner opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111, 112, 113, 114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids; a fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids; and a dispensing mechanism (15, 16) coupled to the base. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 17, the body includes slots (101'). Regarding claim 18, the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21). Regarding claim 19, the interior of the compartments has a sloped area and a reservoir area (see Figs. 2 and 3). Regarding claim 22, Reed ('017) discloses a reusable container

comprising a body (2) having a first side and a second side and a plurality of compartments (24,27) each having a front, a back, a planar first side, a planar second side and a base; one or more removable lids (25, 26 and/or 3) coupled to the compartments having an outer side, an inner opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111,112,113,114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids extending into a corresponding compartment; a fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids; and a dispensing mechanism (15,16) coupled to the base. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). See also *In re Larson*, 144 USPQ 347, 349 (CCPA 1965) regarding the obviousness of making part integral.

Regarding claim 23, the paint compartments are single walled (see Fig. 5). Regarding claim 24, the body includes slots (101'). Regarding claim 25 the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21). Regarding claim 26, the interior of the compartments has a sloped area and a reservoir area (see Figs. 2 and 3). Regarding claims 29-33 a structure which dispenses beverages would be capable of dispensing paint, because the term "paint" includes liquids of similar consistency to common beverages. Applicant argues that a dispensing mechanism which allows paint to flow is necessarily bigger than the size of a beverage dispensing mechanism. Contrary to applicant's arguments, paint may be in the same viscosity range as beverages. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24), while Cole-Palmer's Food TechSource discloses that milk, cream and tomato juice have viscosities of 3.2, 16.5, and 176 centipoise respectively. The dispensing mechanism of Reed ('017) is shown in Figs. 1 and 3 and described in col. 5, lines 11-37.

7. Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017) in view of Briggs (US 6,109,482). The apparatus of Reed ('017), discussed above regarding claims 16 and 22, fails to include rounded ribs and channels. Briggs ('482) discloses rounded ribs (44) and channels/grooves (42). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Reed ('017) with ribs and channels/grooves as taught by Briggs ('482), because Briggs ('482) states that such ribs and grooves provided the

benefit of allowing removable side-by-side coupling of a plurality of unit apparatuses (see col. 5. lines 13-32).

***Allowable Subject Matter***

8. Claims 20 and 27 are allowed.

***Conclusion***

9. The examiner has been directed to reopen prosecution to further address means-plus-function recitations.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 7:30-4:00 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

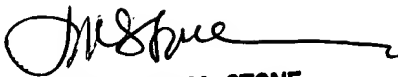
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DLS

  
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